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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/701,536 06/18/2001		Gwong-Jen J. Chang	14114.0332U2	5492	
24197	7590 01/13/2005		EXAMINER		
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET			PARKIN, JEFFREY S		
SUITE 1600	WION STREET	ART UNIT	PAPER NUMBER		
PORTLAND, OR 97204			1648		

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

		Applicati	n No.	Applicant(s)			
		09/701,53	6	CHANG, GWONG-JEN J.			
	Office Action Summary	Examiner		Art Unit			
		Jeffrey S.	Parkin, Ph.D.	1648			
Davied 6	The MAILING DATE of this communic	cation appears on the	cover sheet with the d	correspondence ad	dress		
Period fo	• •				•		
THE - Exte after - If the - If NO - Failu Any	ORTENED STATUTORY PERIOD FO MAILING DATE OF THIS COMMUNIC unsions of time may be available under the provisions of SIX (6) MONTHS from the mailing date of this commuse period for reply specified above is less than thirty (30) operiod for reply is specified above, the maximum stature to reply within the set or extended period for reply we reply received by the Office later than three months afted patent term adjustment. See 37 CFR 1.704(b).	CATION. f 37 CFR 1.136(a). In no evenication. d days, a reply within the statutory period will apply and wirill, by statute, cause the apply	ent, however, may a reply be tin story minimum of thirty (30) day Il expire SIX (6) MONTHS from ication to become ABANDONE	nely filed s will be considered timely the mailing date of this co D (35 U.S.C. § 133).			
Status							
1)	Responsive to communication(s) filed	l on 03 November 20	004				
·	This action is FINAL . 2b) ☐ This action is non-final.						
3) Since this application is in condition for allowance except for formal matters, prosecution as to the							
,	closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.						
Disposit	ion of Claims						
		in the application					
=	Claim(s) <u>23-54 and 69</u> is/are pending in the application. 4a) Of the above claim(s) is/are withdrawn from consideration.						
		s willidiawn ifoni coi	isideration.				
-	Claim(s) is/are allowed.						
7)	Claim(s) <u>23-54 and 69</u> is/are rejected. Claim(s) is/are objected to.						
' =	Claim(s) are subject to restricti	ion and/or election re	aguirement		•		
		ion and/or clockon re	equirement.				
Applicat	ion Papers						
,	The specification is objected to by the		_				
10)	The drawing(s) filed on is/are:						
	Applicant may not request that any object	• • •	•	, ,			
	Replacement drawing sheet(s) including t	•			` '		
11)[The oath or declaration is objected to	by the Examiner. No	te the attached Office	Action or form PT	O-152.		
Priority (under 35 U.S.C. § 119						
•	Acknowledgment is made of a claim for All b) Some * c) None of:)-(d) or (f).			
	1. Certified copies of the priority d						
	2. Certified copies of the priority d				04		
	3. Copies of the certified copies of	•		ed in this National	Stage		
* 0	application from the Internation			لم			
3	See the attached detailed Office action	TOT A HIST OF THE CERTIF	ieu copies not receive	u.			
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Attachmen	, ,						
	e of References Cited (PTO-892) of Draftsperson's Patent Drawing Review (PT	O 048)	4) Interview Summary Paper No(s)/Mail Da				
3) 🛛 Infon	e of Draftsperson's Patent Drawing Review (PT mation Disclosure Statement(s) (PTO-1449 or P er No(s)/Mail Date <u>see attached</u> .			ratent Application (PTC)-152)		

Serial No.: 09/701,536 Docket No.: 14114.0332U2
Applicant: Chang, G.-J. J. Filing Date: 06/18/01

Detailed Office Action

Status of the Claims

Acknowledgement is hereby made of receipt and entry of the communication filed 03 November, 2004. Claims 1-34, 55-68, and 70-86 were canceled without prejudice or disclaimer. Claims 35-54 and 69 are currently under examination.

Information Disclosure Statement

The information disclosure statements filed 12 October, and 02 December, 2004, have been placed in the application file and the information referred to therein has been considered.

35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (e) the invention was described in -
 - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
 - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

The previous rejection of claims 35, 37-43, 45, 46, and 49-54 under 35 U.S.C. § 102(e) as being anticipated by Schmaljohn (2001), is hereby withdrawn in response to the declaration provided by

Gwong-Jen Chang and applicants' arguments.

35 U.S.C. § 103(a)

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The previous rejection of claim 69 under 35 U.S.C. § 103(a) as being unpatentable over Schmaljohn (2001), is hereby withdrawn in response to the declaration provided by Gwong-Jen Chang and applicants' arguments.

The previous rejection of claims 36, 44, 47, and 48 under 35 U.S.C. § 103(a) as being unpatentable over Schmaljohn (2001) in view of Kochel et al. (2002), is hereby withdrawn in response to the declaration provided by Gwong-Jen Chang and applicants' arguments.

Non-statutory Double Patenting

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. In re Thorington, 418 F.2d 528, 163 U.S.P.Q. 644 (C.C.P.A. 1969); In re Vogel, 422 F.2d 438, 164 U.S.P.Q. 619 (C.C.P.A. 1970); In re Van

Ornum, 686 F.2d 937, 214 U.S.P.Q. 761 (C.C.P.A. 1982); In re Longi, 759 F.2d 887, 225 U.S.P.Q. 645 (Fed. Cir. 1985); and In re Goodman, 29 U.S.P.Q.2d 2010 (Fed. Cir. 1993). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. § 3.73(b).

Claims 35-54 and 69 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10, 12-17, 28, 30, 32, 34, and 36 of copending Application No. 09/826,115 in view of Schmaljohn (2001).The claims of the instant application require a transcriptional unit encoding a prM signal sequence, Kozak concensus site, and flaviviral antigens. Schmaljohn (2001) provide prM signal sequences and Kozak concensus sequences. Therefore, it would have been prima facie obvious to one having ordinary skill in the art at the time the invention was made to modify the claims of the '115 application to include a transcriptional unit with a prM signal sequence and Kozak sequences, as taught by Schmaljohn (2001), since this would facilitate the efficient expression of flaviviral antigens. This is a provisional obviousness-type double patenting rejection.

Finality of Office Action

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A

FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Correspondence

Any inquiry concerning this communication should be directed to Jeffrey S. Parkin, Ph.D., whose telephone number is (571) 272-0908. The examiner can normally be reached Monday through Thursday from 10:30 AM to 9:00 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, James C. Housel, can be reached at (571) 272-0902. Direct general status inquiries to the Technology Center 1600 receptionist at (571) 272-1600. Formal communications may be submitted through the official facsimile number which is (703) 872-9306. Hand-carried formal communications should be directed toward the customer window located in Crystal Plaza Two, 2011 South Clark Place, Arlington, VA. Applicants are directed toward the O.G. Notice for further guidance. 1280 O.G. 681. Informal communications may be submitted to the Examiner's RightFAX account at (571) 273-0908.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully,

Jeffrey S. Parkin, Ph.D.

Patent Examiner Art Unit 1648

07 January, 2005